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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,881	08/20/2001	Masaaki Nakashima	P21017	4044

7055 7590 07/12/2005

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

AN, SHAWN S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/931,881	Applicant(s) NAKASHIMA, MASAOKI	
	Examiner Shawn S. An	Art Unit 2613	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 June 0605 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-17.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments are still not persuasive for reasons that follow.

Applicant argues that Jones does not disclose A) the predetermined circuit being arranged along the periphery of the light receiving surface of the image sensor on the base so that a center of the base on the light receiving surface of the image sensor is substantially aligned with a center of the effective imaging region of the image sensor, B) a configuration of an image sensor and a predetermined circuit mounted on a base, C) claims 3 and 11, and D) obviousness assertions between NAKAMURA and SASAKI references.

However, after careful scrutiny of the previously cited prior art references, the Examiner must respectfully disagree, and maintain the previous grounds of rejection for the reasons that follow.

In response to argument A), Nakamura discloses a predetermined circuit (intricate circuitry of the conventional endoscope utilizing CCD (image sensor), visual inherency is emphasized, because conventional endoscope's inherent function is to capture and take out an image signal from the image sensor) being arranged along the periphery of the light receiving surface of the image sensor (Fig. 15, CCD) on the base (Fig. 18, 85) so that a center (see optical axis) of the base on the light receiving surface (coincides with the optical axis of the objective lens system (80)) of the image sensor is substantially aligned with a center (Fig. 15, line C) of the effective imaging region of the image sensor (Figs. 15 and 18; col. 15, lines 2-14).

Furthermore, in contrast to Applicant's previous assertion that the alignment disclosed in Nakamura is not between a center of base and the center of the image sensor, but between a center of lens and a center of the CCD, the alignment as depicted on figure 18 illustrates a center (see optical axis, d6) of the base (85) being substantially aligned with a center (Fig. 15, line C) of the effective imaging region of the image sensor.

In response to argument B), Nakamura discloses configuration of an image sensor (Fig. 15, CCD) and a predetermined circuit (intricate circuitry of the conventional endoscope utilizing CCD (visual inherency is emphasized, because one of an endoscope's inherent function is to capture and take out an image signal from the image sensor) mounted on a base (Fig. 18, 85). Furthermore, the claimed limitation "base" is met by the element 85, whether the base is made up of glass or anything else. Since the Applicant does not claim any details of the base, at least the claimed limitation "base" has been met by the element 85.

In response to argument C), as previously discussed, Nakamura does not seem to disclose the intricate functions of the imaging element (CCD) comprising a signal processing circuit for carrying out an image processing, and a control circuit for carrying out timing control to extract a signal from the image sensor.

However, Sasaki teaches an endoscope system (Fig. 2) comprising a signal processing circuit (37, 43) for carrying out an image processing including generating a video signal, and a control circuit (44) for carrying out timing control to extract a signal from the image sensor.

Therefore, it would have been clearly obvious to a person of ordinary skill in the relevant art employing the Nakamura's endoscope to incorporate the Sasaki's teachings as above for an obvious reasons of carrying out the image processing and timing control to extract a signal from the image sensor, since most of the conventional endoscopes comprise an image processing section and a timing control section for displaying the captured image on a display monitor.

Regarding argument D), and in response to Applicant's argument that there is no suggestion/obviousness to combine the references/embodiments, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).


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